

## **REMARKS**

In the May 8, 2003 Office Action, claims 1-32, 36-48 and 50-53 stand rejected in view of prior art. On the other hand, claim 49 was allowed and claims 33-35 were indicated as containing allowable subject matter. Applicant wishes to thank the Examiner for the indication of allowable subject matter. Additionally, claim 1 was provisionally rejected under the judicially created doctrine of obviousness-type double patenting. No other objections or rejections were made in the Office Action.

### ***Status of Claims and Amendments***

In response, Applicant has amended independent claims 1, 11, 41 and 51 to more clearly distinguish the prior art and/or to clarify these claims. Also, Applicant has made minor clarifying amendments to independent claim 50. Thus, claims 1-53 are pending, with claims 1, 2, 11, 18, 41 and 49-51 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of the above amendments and the following comments.

### ***Rejections - 35 U.S.C. § 112***

In paragraphs 2 and 3 (page 2), claims 1, 15 and 52 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, the Office Action indicates that the phrase "said center longitudinal axis" in claim 1 lacks proper antecedent basis, and that claims 15 and 52 are indefinite due to their dependency from claim 1.

In response, Applicant has amended independent claim 1 to overcome this rejection. Specifically, independent claim 1 now requires a longitudinal axis of the base member and later references "said longitudinal axis". Applicant believes claims 1, 15 and 52 now fully comply with 35 U.S.C. §112. Accordingly, withdrawal of this rejection is respectfully requested.

### ***Rejections - 35 U.S.C. § 102***

In paragraphs 4-7 (pages 2-5) of the Office Action, claims 1, 15, 41-45 and 51 stand rejected under 35 U.S.C. §102 as being anticipated by a variety of references. In particular, these claims stand rejected as follows:

Claim 1 stands rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,123,354 to Laughlin et al. (hereinafter "the Laughlin '354 patent").

Claims 1 and 15 stand rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,293,578 to Anderson et al. (hereinafter "the Anderson patent").

Claims 41-45 and 51 stand rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 5,690,351 to Karol (hereinafter "the Karol patent").

In response to the above rejections, Applicant has amended independent claims 1, 41 and 51 to more clearly distinguish these claims over the prior art. In particular, independent claim 1 has been amended to clarify that the rear binding member is configured and arranged without a lever portion that extends away from the longitudinal axis out of the boot receiving area beyond the side attachment portion to release the rear binding member. Regarding independent claim 41, Applicant has amended this claim to clarify that the first and second notches are open in the rearward direction such that the notches are viewable in a longitudinal direction from behind the boot and such that first and second latches of a snowboard binding arranged in the first and second notches can slide longitudinally rearwardly within the first and second notches to positions located rearwardly of the boot out of engagement with the first and second notches when the snowboard boot is coupled to the snowboard binding and moved longitudinally forward relative thereto. Finally, regarding independent claim 51, Applicant has amended this claim to clarify that each of the notches has an abutment surface that faces upwardly relative to the snowboard boot that is selectively engageable with latches of a snowboard binding such that the snowboard boot can be coupled to the snowboard binding at two different heights relative to the snowboard binding. Applicant does not believe the unique arrangements of independent claims 1, 41 and 51 are disclosed in the references cited in the Office Action, especially in view of the above clarifying amendments to these independent claims.

Specifically, regarding independent claim 1, the Laughlin '354 patent fails to disclose a latch that moves downwardly toward the base member and laterally outwardly away from the longitudinal axis upon application of a force on the latch member in a direction substantially toward the base member by the snowboard boot, and that moves upwardly away from the base member and laterally inwardly upon removal of the force, as required by independent claim 1. Rather, in the Laughlin patent, the latches move downwardly and

inwardly toward the center longitudinal axis upon application of a force in a direction toward the base of the binding, not downwardly and outwardly away from the center longitudinal axis, as required by independent claims 1. Moreover, the rear binding members in the Laughlin '354 patent have lever portions that extend outwardly beyond the boot receiving area and the side attachment portions. Thus, the Laughlin patent also fails to disclose a rear binding member arranged and configured without a lever portion that extends away from the longitudinal axis out of the boot receiving area beyond the side attachment portion to release the rear binding member. Accordingly, withdrawal of this rejection is respectfully requested.

Regarding the rejection of independent claim 1 as being unpatentable over the Anderson patent, clearly, the Anderson patent discloses a rear binding member 76 with a lever portion that extends away from the center axis beyond the remaining parts of the binding, as best seen in Figures 4, 5 and 6. The lever portion or release lever of the Anderson patent is located complete outside of a so-called boot receiving area. Thus, the Anderson patent fails to disclose a rear binding member configured and arranged without a lever portion that extends away from the longitudinal axis out of the boot receiving area beyond the side attachment portion to release the rear binding member. Accordingly, withdrawal of this rejection is respectfully requested.

Turning now to the rejection of independent claim 41, clearly, the Karol patent fails to disclose notches that are open in the rearward direction such that they are viewable from behind the boot and such that latches of the snowboard binding that are arranged in the notches can slide longitudinally rearwardly within the notches to positions located rearwardly of the boot, as now required by independent claim 41. Rather, in the Karol patent the so-called binding members prevent longitudinal movement of the boot relative to the binding when the boot is coupled to the binding. Moreover, the so-called notches are not open in the rearward direction, as required by independent claim 41. Rather, the cut outs of the Karol patent have front and rear end surfaces and a projection extending outwardly within the cutout. The catch is received in the cutout to surround the projection to be non-slidable in the longitudinal direction due to the end surfaces and the projection. Accordingly, withdrawal of the rejection of independent claim 41 is respectfully requested. Moreover, withdrawal of the rejections of dependent claims 42-45 are also respectfully requested since these claims depend from independent claim 41, and thus, further limit independent claim 41.

Regarding the rejection of independent claim 51 as being unpatentable over the Karol patent, Applicant believes the Karol patent clearly fails to disclose a pair of substantially parallel notches on each side of the snowboard boot with each notch having an abutment surface that faces upwardly relative to the snowboard boot, as now required by independent claim 51. At best, each side of the snowboard boot of the Karol patent has a single notch with a single abutment surface that faces upwardly to engage the snowboard binding. Moreover, the snowboard boot of the Karol patent cannot be coupled to the snowboard binding at two different heights relative to the snowboard binding since it does not include a pair of notches located on each side, as currently claimed. Accordingly, withdrawal of the rejection of independent claim 51 is respectfully requested.

***Rejections - 35 U.S.C. § 103***

In paragraphs 8-13 (pages 6-14) of the Office Action, claims 2-14, 16-32, 36-40, 46-48, 50, 52 and 53 stand rejected under 35 U.S.C. §103(a) as being unpatentable over a variety of combinations of references. In particular, these claims stand rejected as follows:

Claims 2, 4-10, 16 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Anderson patent in view of the Laughlin '354 patent. Applicant believes the Office Action inadvertently references the Laughlin "345" patent because no such document (i.e., Laughlin "245") has been cited in this application. Accordingly, Applicant is responding as if "345" is --354--.

Claims 3, 18-32, 36-40, 50 and 52 stand rejected as being unpatentable over the Anderson patent in view of the Laughlin '354 patent, and further in view of U.S. Patent No. 6,177,584 to Beyl (hereinafter "the Beyl patent").

Claims 11-14 and 53 stand rejected as being unpatentable over the Laughlin '354 patent in view of U.S. Patent No. 5,544,909 to Laughlin et al. (hereinafter "the Laughlin '909 patent").

Claim 46 stands rejected as being unpatentable over the Karol patent.

Claims 47 and 48 stand rejected as being unpatentable over the Karol patent in view of U.S. Patent No. 5,915,720 to Turner et al. (hereinafter "the Turner patent").

Referring initially to the rejections of claims 2-10, 16-32, 36-40 and 50, Applicant respectfully traverses the rejections set forth in the Office Action, as explained below.

Specifically, independent claim 2 requires first and second latch members arranged to move downwardly toward the base member and laterally outwardly away from each other and away from said longitudinal axis upon application of a force on the first and second latch members in the direction substantially towards said base member. Independent claim 18 requires a binding system with a bind very similar to that of independent claim 2. Finally, independent claim 50 is similar to original claim 18 but requires first and second latch members and first and second rear catches configured to allow forward longitudinal movement of the snowboard boot relative to the snowboard binding when the first and second latch members are holding the first and second rear catches, respectively, and the front binding member and the front catch being configured to limit longitudinal movement of the front catch in a forward direction along the longitudinal axis when the front binding member is in the latched position holding the front catch.

The Office Action indicates that the Anderson patent discloses a single latch member 76 as currently claimed. The Office Action relies on the Laughlin '354 patent to disclose a pair of laterally spaced latch members. The Office Action then asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the second latch member of Anderson to have included a configuration similar to the first latch member, as taught by the Laughlin '354 patent, in order to provide a means of enabling quick manual lever release of both sides of the snowboard boot as taught by the Laughlin '354 patent in order to provide an alternate means of releasing a boot from a snowboard base member. This is the position of the Office Action with respect to independent claim 2. The Office Action then asserts that it would have also been obvious to combine the teachings of Beyl (i.e., a front catch and binding member) to the binding of Anderson patent as modified by the Laughlin '354 patent to result in the invention of independent claims 18 and 50. Applicant respectfully disagrees with these positions of the Office Action.

First, Applicant believes that one of ordinary skill in the art at the time the invention was made would not modify the binding of the Anderson patent to include a pair of identical bindings as shown in the Laughlin '354 patent, as suggested in the Office Action. Second

Applicant believes that it would not have been obvious to combine the teachings of Beyl (i.e., a front catch and binding member) to the binding of Anderson patent as allegedly modified by the Laughlin '354 patent to result in the invention of independent claims 18 and 50.

Specifically, Applicant believes that modifying the device of the Anderson patent as suggested in the Office Action to include two identical latches would be contrary to the teachings of the Anderson patent. In particular, *the binding of the Anderson patent is designed to allow for rapid exit* (e.g., a single easily accessible release lever). Moreover, *the binding of the Anderson patent is designed with relatively few moving parts and is cost effective to manufacture*. See the Anderson patent at column 3, lines 45-51. In other words, the binding system of the Anderson patent provides a relatively simple, secure, inexpensive binding with relatively few moving parts that is relatively easy to release with one hand. Modifying the device of the Anderson patent as suggested in the Office Action would complicate release from the binding (e.g., due to the need to actuate two release levers), increase the number of parts and increase the costs associated with manufacture. Such a modification would result in a more complicated device with additional unnecessary moving parts. Such a construction is relatively difficult and expensive. Thus, the Anderson patent teaches away from the alleged motivation provided in the Office Action. Accordingly, withdrawal of the rejections of independent claims 2, 18 and 50 is respectfully requested.

Moreover, the binding of the Anderson patent has elongated catches arranged on each side that are substantially centrally located relative to the front and back of the snowboard boot to securely fasten the boot to the binding at a substantially central location, as best seen in Figure 1. On the other hand, the Beyl patent discloses front and rear binding members located substantially at the front and rear locations relative to the boot to securely fasten the boot to the binding in Figures 1-5, or binding members located at a substantially central location in Figures 6-7. In other words, the Beyl patent teaches locating the bindings at two different locations with one location (i.e., of Figures 6-7) very similar to the location of the binding members of the Anderson patent.

When the binding members are centrally located such as in Figures 6-7 of the Beyl patent, front and rear binding members are eliminated in a manner similar to the Anderson patent. Thus, even though the binding systems of Anderson and Beyl operate in different ways, both teach that a front binding member is not needed when the boot is coupled securely at a substantially central location. Accordingly, there is no motivation to combine the front

binding member of the Beyl patent with the so-called modified binding system of the Anderson patent. In fact, such an additional binding member would be redundant and unnecessary. Accordingly, withdrawal of the rejection on independent claims 18 and 50 is respectfully requested.

Additionally, Applicant notes that such a modification (i.e., adding an additional front binding member) would be contrary to the teachings of the Anderson patent. In particular, *the binding of the Anderson patent is designed to allow for rapid exit* (e.g., a single easily accessible release lever). Moreover, *the binding of the Anderson patent is designed with relatively few moving parts and is cost effective to manufacture*. See the Anderson patent at column 3, lines 45-51. Modifying the so-called modified binding system of the Anderson patent to include an additional front binding member as suggested in the Office Action would further complicate release from the binding, further increase the number of parts and further increase the costs associated with manufacture. Such a modification would result in an even more complicated device with still more unnecessary moving parts. Such a construction is more difficult and expensive. Thus, the Anderson patent teaches away from the alleged motivation provided in the Office Action. Accordingly, withdrawal of the rejection of independent claims 18 and 50 is respectfully requested.

In view of the foregoing comments, Applicant respectfully requests withdrawal of the rejections of independent claims 2, 18 and 50. Applicant also respectfully requests withdrawal of the rejection of dependent claims 3-10, 16, 17, 19-32 and 36-40 since these claims depend from independent claims 2 and 18, and thus, further limit their respective independent claims.

Regarding dependent claim 52, which depends from independent claim 1, Applicant believes neither the Laughlin '354 patent nor the Beyl patent account for the deficiencies of the Anderson patent with respect to independent claim 1 as now amended, as discussed above. Accordingly, withdrawal of this rejection is respectfully requested.

Referring now to the rejection of claims 11-14 and 53, this rejection is respectfully traversed, especially in view of the clarifying amendments to independent claim 11. Independent claim 11 now requires a front binding member including a connecting portion coupled to the front portion of the base member and a binding flange extending from the connecting portion that is arranged to move in a forward and downward direction relative to the base member when moving from the latched position to the release position relative to the

longitudinal axis, the binding flange being arranged and configured to limit upward movement of a front catch of a snowboard binding in the latched position and the connecting portion extending from a forward end of the binding flange in the latched position such that the connecting portion is configured to limit forward movement of the front catch of the snowboard boot along the longitudinal axis in the latched position. Independent claim 11 also requires a rear binding member binding member coupled to a first lateral side of the rear portion of the base member, the rear binding member including a first latch member movable relative to the base member, the first latch member being pivotally supported about a first pivot axis substantially parallel to the longitudinal axis, the first latch member being arranged to move laterally upon application of a force in a direction substantially towards the base member.

The Office Action indicates that the Laughlin '354 discloses all of the limitations of independent claim 11, except the front binding member and front catch. The Office Action relies on the Laughlin '909 patent to disclose a front binding member and asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the part(s) of the binding arrangement of the Laughlin '909 patent with the binding system of the Laughlin '354 patent. Applicant respectfully disagrees with the position of the Office Action as explained below.

First, Applicant believes one of ordinary skill in the art would not combine the teachings of the Laughlin patents, as suggested in the Office Action. Second, Applicant believes that even if the teachings of the Laughlin patents were combined, it would not result in the invention of independent claim 11, especially as now amended.

Specifically, at best, if one of ordinary skilled in the art were to combine the front bail of the Laughlin '909 patent with the binding of the Laughlin '354 patent, such a hypothetical combination would not result in the claimed front catch. More specifically, the front catch of the Laughlin '909 patent does include the connecting portion and binding flange as currently claimed. At best, the front bail of the Laughlin '909 patent has a connecting portion extending from the rear of the so-called binding flange. Even if the rear bail of the Laughlin '909 patent were used as a front catch as suggested in the Office Action, the rear bail would have to be used in a configuration similar to the front bail in order to function. Thus, even if the Laughlin '354 patent were somehow combined with the bail(s) of the Laughlin '909 patent, it would not result in the claimed invention.

Moreover, there is no suggestion or motivation to combine the Laughlin patents as suggested in the Office Action. Many different types of snowboard bindings have been designed over the years. These snowboard bindings often use different structures to accomplish the same result (coupling a boot thereto) with different desired effects. In other words, each binding is usually designed to accomplish the desired effects in a different, unique way. Sometimes, snowboard bindings are designed in order to eliminate certain parts of prior bindings, to simplify the design, improve binding characteristics, or decrease costs. In any case, different parts of these bindings are typically not interchangeable, unless there is some expressed suggestion or motivation to do so. Moreover, one of ordinary skill in the art does not typically selectively combine isolated features from various snowboard bindings, ignoring the rest of the binding structure. Such an exercise requires impermissible hindsight reasoning. Accordingly, Applicant believes there is no suggestion or motivation to combine the Laughlin patents as suggested in the Office Action.

In view of the foregoing amendments and comments, withdrawal of the rejection of independent claim 11 is respectfully requested. Applicant also respectfully requests withdrawal of the rejection of dependent claims 12-14 and 53 since these claims depend from independent claim 11, and thus, further limit independent claim 11.

Referring now to the rejection of claim 46, which depends from independent claim 41, Applicant believes there is no suggestion or motivation to modify the boot of the Karol patent to result in the unique arrangement of independent claim 41 as now amended, as discussed above. Thus, even if the Karol patent were modified as suggested in the Office Action, it would not result in the claimed invention. Accordingly, withdrawal of this rejection is respectfully requested.

Referring now to the rejection of claims 47 and 48, which depend from independent claim 41, Applicant believes the Turner patent fails to account for the deficiencies of the Karol patent with respect to independent claim 41 as now amended, as discussed above. Thus, even if the Karol patent were modified as suggested in the Office Action, it would not result in the claimed invention. Accordingly, withdrawal of this rejection is respectfully requested.

It is well settled in U.S. patent law that the mere fact that the prior art can be modified does *not* make the modification obvious, unless the prior art *suggests* the desirability of the modification. Accordingly, the prior art of record lacks any suggestion or expectation of

success for combining the patents to create the Applicant's unique arrangements of independent claims 1, 2, 11, 18, 41, and 50. Accordingly, withdrawal of the above rejections is respectfully requested.

***Double Patenting***

In paragraph 14-15 (pages 13-15), claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 10/074,253 in view of the Anderson patent. The Office Action indicates that although the conflicting claims are not identical, they are not patentably distinct from each other in view of the Anderson patent. The double patenting rejection is indicated as being a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant notes that if a provisional double patenting rejection is the only rejection remaining in an application, the provisional double patenting rejection should then be withdrawn to allow that application to issue as a patent. (See MPEP 804, pp. 800-19). As discussed above, Applicant believes the claims of this application, especially as now amended, are allowable over the prior art. Thus, Applicant believes the provisional double patenting rejection set forth in this Office Action should be withdrawn, and this application should be allowed. Accordingly, Applicant respectfully requests reconsideration of this rejection.

Applicant acknowledges that if the later filed Application No. 10/074,253 issues as patent(s) prior to the instant application being patented, the provisional double patenting rejection in the instant application could be changed to an actual double patenting rejection.

***Terminal Disclaimer***

In paragraph 16 of the Office Action, Applicant's Terminal Disclaimer filed on March 20, 2003 is acknowledged as being received, accepted and recorded.

***Allowable Subject Matter***

In paragraphs 17-18 (page 16) of the Office Action, claims 33-35 were objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In addition, claim 49 was indicated as being allowed. Applicant wishes to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application.

***Response to Arguments***

Serial No.: 09/836,545  
Amendment dated August 8, 2003  
Reply to Office Action of May 8, 2003

In paragraph 19 (page 16), the Office Action indicates that arguments filed on April 17, 2003 with regards to claim 1 have been considered but are not persuasive because "the center longitudinal axis of the base member" was more specific than the claim language. In response, Applicant has amended independent claim 1 to overcome the rejection under 35 U.S.C. §112, second paragraph.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-53 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If there are any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,



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